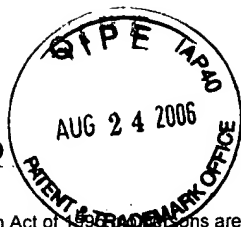


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

96-3-512 CON 1 CP 2

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on _____

Signature _____

Typed or printed name _____

Application Number

09/759,100

Filed

Jan. 13, 2001

First Named Inventor

W. David SHAMBROOM

Art Unit

2131

Examiner

Kaveh Abrishamkar

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒

attorney or agent of record.

Registration number

46,508

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Joseph E. Paly for Jeff Parkout

Typed or printed name

571-203-2713

Telephone number

August 29, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 2131
PATENT
Customer No. 25537
Attorney Docket No. 96-3-512CON1CP2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
W. David SHAMBROOM)	Group Art Unit: 2131
)	
Application No.: 09/759,100)	Examiner: Kaveh Abrishamkar
)	
Filed: January 12, 2001)	
)	
For: PLATFORM-NEUTRAL SYSTEM)	Confirmation No.: 1842
AND METHOD FOR PROVIDING)	
SECURE REMOTE OPERATIONS)	
OVER AN INSECURE)	
COMPUTER NETWORK)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the rejections in the Final Office Action mailed on April 4, 2006. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

This Pre-Appeal Brief request for review follows the Examiner's Advisory Action mailed July 11, 2006.

Claims 1-36 remain pending, with claims 1-36 being the subject of this Pre-Appeal Brief request for review. In the Final Office Action, the Examiner rejected claims 1-36 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,590,199 to Krajewski, Jr. et al. ("*Krajewski*") in view of U.S. Patent No. 5,005,200 to Fischer ("*Fischer*").

The Examiner's rejection contains clear errors in the form of inconsistencies in the application of the prior art to Applicant's claims.

Claim 1 recites a combination including, for example,

A method of enhancing the security of a message sent by a principal from a client computer through a network server to a destination server, comprising the steps of:

obtaining by the client computer credentials for authorizing the principal from a validation center;

establishing a first secure connection for exchanging data between the client and the network server;

transmitting from the client computer to the network server over the first secure connection the principal-authenticating credentials and the message;

transmitting the principal-authenticating credentials from the network server to the validation center;

transmitting permission data for the network server from the validation center to the network server based on the principal-authenticating credentials;

verifying the authorization of the principal in the network server to access a digital certificate and issuing a digital certificate to the network server;

establishing a second secure connection for exchanging data between the network server and the destination server based on the digital certificate; and

transmitting the message from the network server to the destination server over the second secure connection

(emphasis added). The cited references, alone or in combination, do not teach at least the claimed client computer, network computer, validation center, and destination server.

Krajewski teaches an untrusted workstation 14 used as a client, a service 20 (referred interchangeably as a computer, network, and system server/service), and a Kerberos authorization server (KAS) 32 (*Krajewski* Fig. 3 and col. 5, lines 46-54). Service 20 executes a program referred to as “server Kerberos” that interacts with KAS 32 (*Krajewski* Fig. 4, col. 5 lines 39-45). The untrusted workstation 14 performs some authentication processing using a locally available smart card 30.

The Examiner’s position is difficult to decipher. Consider first the non-final Office Action mailed August 9, 2005. Referring to the claim language “transmitting the principal authenticating credentials from the network server to the validation center,” the Examiner cites portions of *Krajewski* disclosing transferring a ticket from the client to the smart card 30 (non-Final Office Action p. 3 ¶ 2 line 6 - p. 4 line 2), seeming to allege that the smart card 30 corresponds to the claimed network server. However, in the text accompanying the citation, the Examiner appears to indicate that the service 20, and not the smart card 30, corresponds to the claimed network server. At the end of this very same paragraph, the Examiner appears to equate the service 20 with the claimed destination server (non-Final Office Action page 4, lines 11-13).

In response to the Examiner’s inconsistent mapping of devices in *Krajewski* to the claimed network and destination servers, Applicant requested that the Examiner provide some reasonable structure to his position, by setting forth the correlation between devices in *Krajewski* with the claimed client computer, network server,

destination server, and validation center, in tabular form (Reply to Office Action mailed Jan. 10, 2006, page 11 lines 26-28). Applicant notes that the Examiner did not do so, and submits that this is likely because such a table would be impossible to construct without coming to the conclusion that *Krajewski* simply fails to teach the claimed client computer, network server, destination server, and validation center of claim 1.

In the Final Office Action mailed April 4, 2006, the Examiner again failed to provide a coherent explanation of how the devices in *Krajewski* correspond to the claimed network and destination server. In response to Applicant's arguments, the Examiner appears to reassert that the service 20 corresponds to the claimed network server, but then asserts that the server Kerberos corresponds to the claimed destination server (Final Office Action p. 2 ¶ 4, lines 11-12). Note that claim 1 recites "exchanging data between the network server and the destination server based on the digital certificate," but *Krajewski* clearly shows the server Kerberos located on the service 20 (see Fig. 4). The Examiner's mapping appears to assert the unusual position that the service 20 uses a digital certificate in order to communicate with its own software.

In an Advisory Action dated July 11, 2006, the Examiner appeared to retreat from his position that server Kerberos constitutes the claimed destination server, instead alleging only that *Fischer* discloses the claimed destination server. However, note that in both the non-Final and Final Office Actions, the Examiner relied on *Fischer* to teach the claimed digital certificate, not the destination server. If the Examiner's position is now that *Krajewski* does not teach the claimed destination server, but rather *Fischer* does so, Applicant has not had an opportunity to address this position.

In sum, the Examiner has made a number of inconsistent allegations to support the Examiner's position that *Krajewski* teaches each of the claimed client computer, network computer, validation center, and destination server. At various times the Examiner has alleged that service 20 corresponds to both the claimed network or destination server, has alleged that the smart card 30 corresponds to the claimed network server, and has alleged that the server Kerberos corresponds to the claimed destination server. Finally, in the Advisory Action, the Examiner appears to indicate that *Fischer*, and not *Krajewski*, teaches the claimed destination server.


In light of the inconsistent application of the teachings of the prior art, Applicant submits that the Examiner's position, as articulated in the Office Actions and Advisory Action, cannot reasonably be read to approximate a *prima facie* case of obviousness. Applicant requests that the board of examiners withdraw the rejection.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 21, 2006

By:  *for* Reg. No. 36,743
Jeffrey A. Berkowitz
Reg. No. 36,743